

REMARKS

The Office Action of May 30 2003 rejected claims 1-19. By this paper, claims 1, 7 and 14 have been amended. Applicants respectfully request favorable reconsideration of the pending claims in view of the amendments made herein.

The Office Action rejected claims 1-2, 6-7, 14-15 and 19 as being unpatentable under 35 U.S.C. §102(b) over U.S. Patent No. 4,961,223 to Sutton (Sutton '223). Claims 3-4, 10-12, 16-17, 5 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton '223 in view of United States Patent No. 6,341,163 to Castle, and the Office Action was silent on claims 8 and 9.

Each rejection is based on the assertion that Sutton '223 teaches and discloses a telephone shoulder rest with base portions which "abut[] against a handset" such that the shoulder rest can conform to different shaped handsets. The plain language of Sutton '223 provides that, rather than conform to differently shaped telephone handsets, its invention "is intended for use with a standard basically parallelepipedal handset." Col. 2, ll. 63-64. Further Sutton '223 teaches that its clips (components 17 and 18) have a pair of L-shaped tabs (e.g., component 19) which sit flat on the back of the handset and also engages around the side and slightly around the front of the handset. Col. 3, ll. 17-22. These tabs are tightened as needed by the use of a screw (component 22) in order to secure the shoulder rest to the cellular telephone handset in a manner which also allows the shoulder rest to be readily released from the cellular telephone.

In contrast, the present invention, as further clarified by the present amendments, utilizes a fundamentally different combination. Rather than rely on releasable mechanical pressure applied by screws and tabs which surround the handset, Applicant's claimed invention abuts and

adheres to the back of the handset. This claimed combination is simply not taught by Sutton '223, and as such the rejections under 35 U.S.C. § 102(b) cannot stand.

Even more, any attempt to modify Sutton '223 to create the presently claimed invention would simply be improper. The rigid structure of Sutton '223 is for use on cellular telephones. It is simply not designed to be able to conform to curved handsets such as those shown in an earlier invention by Mr. Sutton where he discloses a shoulder rest for a conventional telephone (United States Patent No. 4,759,058 (Sutton '058)). While Mr. Sutton has multiple patents for telephone shoulder rests, he was simply unable to solve the problem of creating a shoulder rest capable of conforming to almost any shaped telephone as in the present invention. Sutton '223 is explicitly intended for flat "standard basically parallelepipedal handset[s]. Only by hindsight, after examining Applicant's disclosure, could this system be modified to be flexible and utilize adhesive and not solely mechanical pressure to secure the shoulder rest to the telephone. Similarly, Sutton '058 lacks the base portions with the cut-out portion of the shoulder rest which would allow it to fit any type of curved or flat telephone.

Claims 3-4 and 10-12 further claim the use of a flat, flexible strap of material between the base portions of the shoulder rest (or method for making the same). Such a flat, flexible material is utilized by Sutton '058 (although Sutton '058 does not have a cut-out portion), but is explicitly not contained or taught by Sutton '223. It was not obvious to Mr. Sutton to modify Sutton '223 to include such a strap of material and such a modification is not obvious without the benefit of Applicant's disclosure. This is true because no suggestion or motivation exists to add such a material or utilize any adhesive in conjunction with Sutton '223. For example, use of adhesive in conjunction with Sutton '223 would destroy the ability of the user to release the shoulder rest from the cellular telephone. This would substantially increase the size and inconvenience of the

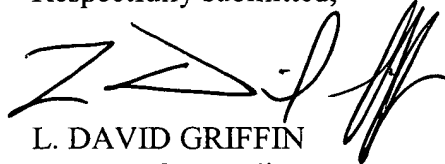
Sutton '223 device and is exactly why one of ordinary skill would not so modify Sutton '223. Without a motivation to combine or otherwise modify Sutton '223, the rejections under 35 U.S.C. § 103(a) cannot stand. *In re Geiger*, 815 F.2d 686, 688 [2 USPQ2d 1276] (Fed. Cir. 1987).

Attached hereto is a marked-up version of the changes made to the previous version of the specification and claims by this amendment. The attached pages are captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

For the foregoing reasons, Applicant submits that the pending claims are in condition for allowance and courteously request favorable action. If there are any outstanding issues that could be resolved by telephone, the Examiner is invited to contact the undersigned attorney.

Dated this 1st day of December, 2003.

Respectfully submitted,



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